

**REMARKS**

Claims 2-7, 10, 11, and 17 are pending. Claims 1, 8-9 and 12-16 were cancelled. Claim 17 was newly added. The rejections set forth in the Office Action are respectfully traversed below.

**Claim Rejections Under 35 USC §112**

Claims 2, 6, and 10-11 were rejected under 35 USC §112, second paragraph. The claims were amended to improve their form under U.S. claims drafting practice and to clarify features of the invention. As amended, the claims meet all the requirements under 35 USC §112, second paragraph.

**Claim Rejections - 35 U.S.C. §103**

Claims 3, 4 and 10 were rejected under 35 USC §103(a) over Applicants' Fig. 3 in view of **Ramm et al.** (U.S. Patent No. 6,345,115). It is submitted that these rejections are now moot since Applicants' Fig. 3 was erroneously described as prior art. This Amendment amended the Specification and Drawings to correct an error regarding the status of Figures 3, 4A, and 4B, as well as errors in the light intensity distribution curve depicted in Figure 3. These errors were recently discovered by the inventor, Takeo Tanaami (see attached Rule 132 Declaration by same). The primary reliance on Applicants' Fig. 3 in making these rejections under 35 USC §103 cannot be sustained, and should be withdrawn.

As noted, Figure 3 is not "prior art." Instead, Figure 3 is based on the subject matter described in the inventors' related Japanese Patent Application No. 2001-2264. Basically, Figure

3 relates to the inventors' own work. Figures 4A and 4B relate to Figure 3. All references to Figures 3, 4A and 4B as being "prior art" or being "conventional" in the specification and drawings are incorrect. As indicated on page 4, lines 17 – 20, "Figure 3 is a schematic view of the biochip reader using a microlens array system illustrating its principle and configuration, mentioned in Japanese Patent Application No. 2001-2264 *submitted by the applicant concerned.*" The Applicants of the present U.S. application are the same Applicants of Japanese Patent Application No. 2001-2264 (see, also, U.S. Patent No. 6,494,373, submitted with the concurrently filed Information Disclosure Statement).

A Declaration Under 37 C.F.R. §1.132 executed by Takeo Tanaami, one of the inventors of the present application, is attached to attest to the origins of the subject matter described in Figure 3 of the present application in support of the present corrections thereto.

Neither Japanese Patent Application No. 2001-2264 nor its corresponding U.S. Patent No. 6,494,373 constitute prior art under any provision of 35 U.S.C. §102. As stated by the Federal Circuit in *Riverwood Int'l Corp. v. R. A. Jones & Co., Inc.*, 324 F.3d 1346, 66 U.S.P.Q. 2d 1331, (Fed. Cir., 2003), "one's own work may not be considered prior art in the absence of a statutory basis." According to the Federal Circuit's Decision in *Riverwood*, Applicant's are permitted to correct mistaken admissions of "prior art" when such mistaken "prior art" was actually the Applicant's own work. As mentioned above, and as supported by the attached Declaration from one of the inventors, Figures 3, 4A and 4B are based on the Applicants' own work. The mistake in labelling and describing the subject matter of these drawings as prior art arose without any

deceptive intent, and are being corrected by this Submission. It is submitted that no new matter was added.

The light intensity distribution curve depicted in Figure 3 was also corrected by this amendment. In particular, the specification stated that the light intensity distribution curve depicted in Figure 3 has the ratio  $\alpha$  as 10 – 20% (see e.g. page 5, lines 15 – 19). However, the originally depicted ratio  $\alpha$  in Figure 3 looks substantially similar to the ratio  $\alpha$  of the light intensity distribution curve depicted in Figure 16. This is incorrect. The light intensity distribution curve depicted in Figure 3 having the ratio  $\alpha$  as 10 – 20% should be noticeably different than the light intensity distribution curve depicted in Figure 16 that is described in the present specification to have the ratio  $\alpha$  of about 90% (see e.g. page 17, line 22 to page 18, line 1). Accordingly, Figure 3 was corrected above to better reflect the description thereof in the specification. Again, no new matter was added.

In view of the fact that Fig. 3 of the present application is not “prior art,” the current §103 rejections relying on the combination of Applicants’ Fig. 3 and **Ramm** cannot be sustained, and should be withdrawn.

In addition, the Office Action seems to rely on the alleged teaching in **Ramm** for a 0 degrees incident angle on a barrier filter. However, the present claimed invention positively recites an incident angle of  $\pm 5$  degrees or less for the excitation light reflected from the sample and incident to the barrier filter. An incident angle of 0 degrees means that an incident angle does not exist. This would be contrary to the positive recitation of an incident angle. Indeed, other than

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Applicants' Fig. 3, nothing in the cited references disclose a non-zero incident angle. Again, since Applicants' Fig. 3 is not prior art, these rejections cannot be sustained, and should be withdrawn.

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested. If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,  
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Atty. Docket No. 020349

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Enclosures: 1 sheet of Corrected Formal Drawing (Figs. 3, 4A and 4B);  
Rule 132 Declaration  
Information Disclosure Statement (with 1 reference).

**Amendments to the Drawings**

The attached one sheet of drawings is the *replacement* corrected *formal* sheet of drawings including changes to Figs. 3, 4A, and 4B. The light intensity distribution curve depicted in Figure 3 was corrected to correspond with the description in the present specification to have the ratio  $\alpha$  as 10 – 20% (see e.g. page 5, lines 15 – 19), which should be noticeably different than the light intensity distribution curve depicted in Figure 16 that is described in the present specification to have the ratio  $\alpha$  of about 90% (see e.g. page 17, line 22 to page 18, line 1).

Attachment: 1 Replacement Sheet (including Figures 3, 4A and 4B)